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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,977	02/11/2002	Andreas Weber	WEI0036	3028

7590 05/20/2004

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EXAMINER

ROBERTSON, JEFFREY

ART UNIT PAPER NUMBER

1712

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/018,977

Applicant(s)

WEBER ET AL.

Examiner

Jeffrey B. Robertson

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2003 and 23 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-32,37-41 and 47-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-32,37-41 and 47-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Priority

1. Regarding the foreign priority document, the examiner has obtained a copy of the German priority document and has placed the document in the application file.

Response to Amendment

2. It is noted that applicant refers to a marked up copy of a substitute specification (Attachment B) and a clean version of a substitute specification (Attachment C). However, these attachments are not present in the application file. The examiner requests that applicant resubmit these attachments in response to the instant office action. It is noted that the objection to the specification and rejection under 35 U.S.C. 112, 1st paragraph are continued based the absence of these documents in the application file.

Specification

3. The disclosure is objected to because of the following informalities: applicant has not provided sufficient enablement to practice the claimed invention. The examiner has made the following findings based on the enumerated factors:
 - (F) The amount of direction provided by the inventor;
 - (G) The existence of working examples; and
 - (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure. In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

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(F) The amount of direction provided by the inventor:

Applicant sets forth in the second full paragraph on page 3 that the tensile and compressive stresses are adjusted through the selection of an appropriate polymer with respect to molecular weight, degree of hydrolysis, purity, cross-linkable functional groups and by subsequent treatment. Applicant does not provide any guidance on how to select the polymers within the tensile stresses set forth in the claims.

(G) The existence of working examples:

Although there are working examples, none of these examples with respect to the silicon resins set forth tensile stress measurements.

(H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure:

In light of the problems set forth above, one of ordinary skill in the art would have to undergo undue experimentation to obtain the coatings producing the claimed tensile

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 28-32, 37-41, and 47-60 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable

one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As set forth above in paragraph 3, applicant has not described how to generate layers on a glass body from a silicon resin that would fulfill the compressive and tensile stresses required by the claim. The specification does not indicate how the components of the respective polymers are to be chosen to fulfill the limitations of the claims.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 61 is rejected under 35 U.S.C. 102(e) as being anticipated by Peltonen et al. (US 2001/0021733 A1).

In Example 3, page 4, paragraph [0052], Peltonen teaches a dispersion containing polyvinyl alcohol (Mowiol 10-74). On page 5, paragraph [0059], Peltonen teaches that films are formed on glass plates by applying the dispersions and drying them. Peltonen does not expressly teach the tensile stresses set forth by applicant.

However, the tensile stress appears to result from the inherent properties of the particular polyvinyl alcohol used. Glass plates containing Mowiol as a coating would apparently inherently produce the tensile stresses claimed. "[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on inherency' under 35 U.S.C. 102, on prima facie obviousness' under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same...[footnote omitted]." The burden of proof is similar to that required with respect to product-by-process claims. In re Fitzgerald, 619 F. 2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977)).

8. Claims 28, 30-32, 37, 38, and 47-57 are rejected under 35 U.S.C. 102(b) as being anticipated by Marsoner et al. (U.S. Patent No. 4,657,736).

It is noted that this reference was previously cited in the last office action. In considering applicant's arguments, the examiner felt that the following rejection was warranted.

For claims 28, 37, 38, and 57, in column 5, lines 25-39, Marsoner teaches that a glass slide is coated with Elastosil to a thickness of 20 micrometers and cured. Marsoner does not specifically teach the tensile stress. However, since Elastosil is the material used, it is a polydimethylsiloxane that would inherently produce the tensile stress required, since this is consistent with applicant's Example 3, on page 8 of the specification. "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable.

Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

For claims 30 and 31, Marsoner also teaches in the Example that a further layer of Elastosil (polydimethylsiloxane) is applied onto the first layer.

For claims 47-56, Marsoner teaches that these layers also fulfill further functional characteristics of indicators and sensors. Since claims 47-56 appear to recite intended uses of the glass bodies and do not recite any further structure the limitations of these claims are fulfilled.

Response to Arguments

9. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. It is noted that the specification objection and the 35 U.S.C. §112, 1st paragraph rejections have been continued as described above.

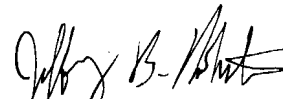
Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dereser (U.S. Patent No. 4,241,136) is cited of interest to the use of polyvinyl alcohols in glass sizing compositions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (571) 272-1092. The examiner can normally be reached on Mon-Fri 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jeffrey B. Robertson
Primary Examiner
Art Unit 1712

JBR